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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-----------------------------|------------------|
| 10/631,070 | 07/31/2003 | Yen-Fu Chen | AUS920030524US1 | 3480 |
| 7590 Rudolf O. Siegesmund Suite 2000 4627 N. Central Expressway Dallas, TX 75205-4017 | | | EXAMINER NEWAY, SAMUEL G | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2626 | |

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS | 01/24/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/631,070 | CHEN ET AL. | |
| | Examiner | Art Unit | |
| | Samuel G. Neway | 2626 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>07/31/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is responsive to the Application filed on July 31, 2003.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1 – 50 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 30 of copending Application No. 10/617,530 in view of

<http://web.archive.org/web/20001204034200/http://www.mandarintools.com/>, Chinese-English Dictionary link.

| Current Application | Co-pending Application 10/617,530 |
|--|---|
| 1. A method comprising: searching a dictionary for an entry | 1. A method comprising: using Unicode to determine a Traditional |

| | |
|--|--|
| <p>containing a Simplified Chinese word; using Unicode to determine a Traditional Chinese word equivalent of a Simplified Chinese word; and using Unicode to translate the Simplified Chinese word into accented Pin Yin word and an English word.</p> <p>5. The method of claim 1 further comprising: accepting the Simplified Chinese word as user input, wherein the Simplified Chinese word is encoded in GB2312 or Unicode.</p> <p>6. The method of claim 1 further comprising: translating the Simplified Chinese word from GB2312 to Unicode.</p> <p>7. The method of claim 1 further comprising: displaying the Simplified Chinese word, the Traditional Chinese word, the accented Pin Yin word, and the English word; and wherein the font size of the Simplified Chinese word and the font size of the Traditional Chinese word is user configurable.</p> | <p>Chinese character equivalent of a Simplified Chinese character.</p> <p>2. The method of claim 1 further comprising: accepting the Simplified Chinese character as user input, wherein the Simplified Chinese character is encoded in GB2312 or Unicode.</p> <p>3. The method of claim 1 further comprising: translating the Simplified Chinese character from GB2312 to Unicode.</p> <p>7. The method of claim 1 further comprising: displaying the Simplified Chinese character and the Traditional Chinese character.</p> |
|--|--|

The current application is directed to finding the corresponding equivalent Chinese character (Traditional and/or Simplified), the corresponding Pin Yin word, and/or an English word to any given word (Chinese, Pin Yin, and/or English) using a dictionary. Copending application No. 10/617,530 is directed to finding the corresponding Chinese character (Traditional and/or Simplified) to a given Chinese word (Traditional and/or Simplified).

Chinese-English Dictionary teaches a method of finding the corresponding equivalent Chinese character (Traditional and/or Simplified), the corresponding Pin Yin word, and/or an English word to any given word (Chinese, Pin Yin, and/or English).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to include the various translations in order to help a non-native Chinese speaker learn the Chinese language by, for example, giving English translations to Chinese words.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 1 – 50 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 - 58 of copending Application No. 10/617,526 in view of <http://web.archive.org/web/20001204034200/http://www.mandarintools.com/>, Chinese-English Dictionary link.

| Current Application | Co-pending Application 10/617,526 |
|---|---|
| <p>1. A method comprising: searching a dictionary for an entry containing a Simplified Chinese word; using Unicode to determine a Traditional Chinese word equivalent of a Simplified Chinese word; and using Unicode to translate the Simplified Chinese word into accented Pin Yin word and an English word.</p> <p>5. The method of claim 1 further comprising: accepting the Simplified Chinese word as user input; wherein the Simplified Chinese word is encoded in</p> | <p>1. A method comprising: using Unicode to determine a Traditional Chinese character equivalent of a Simplified Chinese character; and using Unicode to translate the Simplified Chinese character into accented Pin Yin word and an English word.</p> <p>2. The method of claim 1 further comprising: accepting the Simplified Chinese character as user input, wherein the Simplified Chinese character is encoded in GB2312 or Unicode.</p> |

| | |
|---|---|
| <p>GB2312 or Unicode.</p> <p>6. The method of claim 1 further comprising: translating the Simplified Chinese word from GB2312 to Unicode.</p> <p>7. The method of claim 1 further comprising: displaying the Simplified Chinese word, the Traditional Chinese word, the accented Pin Yin word, and the English word; and wherein the font size of the Simplified Chinese word and the font size of the Traditional Chinese word is user configurable.</p> | <p>3. The method of claim 1 further comprising: translating the Simplified Chinese character from GB2312 to Unicode.</p> <p>8. The method of claim 1 further comprising: displaying the Simplified Chinese character, the Traditional Chinese character, the accented Pin Yin word, and the English word.</p> |
|---|---|

The current application is directed to finding the corresponding equivalent Chinese character (Traditional and/or Simplified), the corresponding Pin Yin word, and/or an English word to any given word (Chinese, Pin Yin, and/or English) using a dictionary. Copending application No. 10/617,526 is directed to finding the corresponding equivalent Chinese character (Traditional and/or Simplified), the corresponding Pin Yin word, and/or an English word to any given word (Chinese, Pin Yin, and/or English)

Chinese-English Dictionary teaches a method of finding the corresponding equivalent Chinese character (Traditional and/or Simplified), the corresponding Pin Yin word, and/or an English word to any given word (Chinese, Pin Yin, and/or English) using a dictionary.

It would have been obvious to one with ordinary skill in the art at the time the invention was made to use a dictionary for the various translations because a dictionary is a database containing translations.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 20 and 45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 20 and 45 recite the limitation "the accented Pin Yin word" in the first line. There is insufficient antecedent basis for this limitation in the claim.

7. Claims 26 – 50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 26 – 50 recite the phrases "program product" and "computer-usable medium"; these phrases are not defined in the specification and it is not clear what they are meant to cover.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 1 – 6, 8 – 13, 15 – 19, 21 – 24, 26 – 31, 33 – 38, 40 – 44, and 46 – 49 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1 – 6, 8 – 13, 15 – 19, 21 – 24, 26 – 31, 33 – 38, 40 – 44, and 46 – 49 appear to be directed to an abstract idea rather than a practical application of the idea. The claims do not result in a physical transformation nor do they appear to provide a tangible result. For example, merely determining the Traditional Chinese character equivalent to a Simplified Chinese character is nothing more than a thought or a computation within a processor. It fails to use or make available for use the result of the determination to enable its functionality and usefulness to be realized.

One possible practical application of the abstract idea is put forth in claim 7 where the result is displayed.

10. Claims 26 – 50 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 26 – 50 recite the limitation “wherein the computer usable medium comprises instructions”. These instructions should be capable of being executed by a computer in order to realize the computer program's functionality.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 15 – 19, and 40 – 44 are rejected under 35 U.S.C. 102(b) as being anticipated by Chinese-English Dictionary

(<http://web.archive.org/web/20001204034200/http://www.mandarintools.com/>).

Claim 15:

Chinese-English Dictionary discloses a method comprising:

searching a dictionary for an entry containing a Pin Yin word ("this

Chinese/English dictionary ...", page 1)

using Unicode to translate a Pin Yin word into a Traditional Chinese character, a Simplified Chinese character, and an English word ("searches can be conducted by Chinese (using either the GB, Big5, or Unicode encodings), ... results will show the Chinese word, the Pin Yin representation of the word, and the English definition", page 1).

Claim 16:

Chinese-English Dictionary discloses the method of claim 15 wherein the entry exactly matches the Pin Yin word ("the Pin Yin at the beginning, end, anywhere, or as the whole entry", page 1).

Claim 17:

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Chinese-English Dictionary discloses the method of claim 15 wherein the entry begins with the Pin Yin word ("the Pin Yin at the beginning, end, anywhere, or as the whole entry", page 1).

Claim 18:

Chinese-English Dictionary discloses the method of claim 15 wherein the entry contains the Pin Yin word anywhere in the entry ("the Pin Yin at the beginning, end, anywhere, or as the whole entry", page 1).

Claim 19:

Chinese-English Dictionary discloses the method of claim 15 wherein the Pin Yin word is an unaccented Pin Yin word to a hybrid Pin Yin word ("you can include or exclude tone numbers, ... you would type "dian shi ji" or "dian4 shi4 ji1" ...", page 1).

Claims 40 – 44:

Claims 40 – 44 are similar in scope and content to claims 15 – 19; therefore they are rejected with the same rationale.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1 – 6, 8 – 13, 21 – 24, 26 – 31, 33 – 38, and 46 – 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chinese-English Dictionary

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(<http://web.archive.org/web/20001204034200/http://www.mandarintools.com/>) in view of Foolsworkshop

(<http://web.archive.org/web/20021206035901/http://www.foolsworkshop.com/ptou/>).

Claim 1:

The Chinese-English Dictionary link from

<http://web.archive.org/web/20001204034200/http://www.mandarintools.com/> discloses a method comprising:

searching a dictionary for an entry containing a Simplified Chinese word ("this Chinese/English dictionary ...", page 1)

using Unicode to determine a Traditional Chinese character equivalent of a Simplified Chinese character ("searches can be conducted by Chinese (using either the GB, Big5, or Unicode encodings), ... results will show the Chinese word", page 1. Note that the Chinese word can be selected to be either Simp. Chinese (GB) or Trad. Chinese (Big5) as shown on top of page 1); and

using Unicode to translate the Simplified Chinese character into Pin Yin word and an English word ("searches can be conducted by Chinese (using either the GB, Big5, or Unicode encodings), ... results will show the Chinese word, the Pin Yin representation of the word, and the English definition", page 1).

Chinese-English Dictionary does not explicitly teach accented Pin Yin translations.

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Foolsworkshop discloses a method of translating Pin Yin into accented Pin Yin (“converts text written in pinyin, with syllable-final tone numbers, into unicode” Note that unicode in this situation represents accented Pin Yin).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to display Pin Yin as accented Pin Yin because “many students and instructors of the Chinese language have a need to display pinyin with tone marks in their documents” so they are easier to read (Foolsworkshop, first line).

Claim 2:

Chinese-English Dictionary and Foolsworkshop disclose the method of claim 1, Chinese-English Dictionary further discloses wherein the entry exactly matches the Simplified Chinese word (“return Chinese entries that exactly match the word ...”, page 1).

Claim 3:

Chinese-English Dictionary and Foolsworkshop disclose the method of claim 1, Chinese-English Dictionary further discloses wherein the entry begins with the Simplified Chinese word (“find entries that start with the characters ...”, page 1).

Claim 4:

Chinese-English Dictionary and Foolsworkshop disclose the method of claim 1, Chinese-English Dictionary further discloses wherein the entry contains the Simplified Chinese word anywhere in the entry (“have the characters anywhere ...”, page 1).

Claim 5:

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Chinese-English Dictionary and Foolsworkshop disclose the method of claim 1, Chinese-English Dictionary further discloses: accepting the Simplified Chinese character as user input, wherein the Simplified Chinese character is encoded in GB2312 or Unicode ("return the results in GB ... or Unicode", page 1).

Claim 6:

Chinese-English Dictionary and Foolsworkshop disclose the method of claim 1, Chinese-English Dictionary further discloses: translating the Simplified Chinese character from GB2312 to Unicode ("return the results in GB ... or Unicode", page 1).

Claims 8 – 13, 21 – 24, 26 – 31, 33 – 38, and 46 – 49:

Claims 8 – 13, 21 – 24, 26 – 31, 33 – 38, and 46 – 49 are similar in scope and content to claims 1 – 6; therefore claims 8 – 13, 21 – 24, 26 – 31, 33 – 38, and 46 – 49 are rejected with the same rationale.

15. Claims 20 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chinese-English Dictionary (<http://web.archive.org/web/20001204034200/http://www.mandarintools.com/>) in view of Hill et al. (USPN 6,023,714)

Claims 20 and 45:

Chinese-English Dictionary discloses the method of claim 15, further comprising: displaying the different characters ("results will show ...", page 1)

but Chinese-English Dictionary does not explicitly disclose the font size as being user configurable.

Hill discloses a method for displaying (similar to Chinese-English displaying) where a browser's font size is user defined.

Therefore it would have been obvious to one with ordinary skill in the art at the time of the invention to make the font size of Chinese-English Dictionary user configured in order "For example, a sight impaired user may define a large browser font size so that a computer-displayed document is easier to read" (Hill, col. 9, lines 33-35)

16. Claims 7, 14, 25, 32, 39, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chinese-English Dictionary

(<http://web.archive.org/web/20001204034200/http://www.mandarintools.com/>) in view of Foolsworkshop

(<http://web.archive.org/web/20021206035901/http://www.foolsworkshop.com/ptou/>) and in further view of Hill et al. (USPN 6,023,714)

Claims 7, 14, 25, 32, 39, and 50:

Chinese-English Dictionary discloses the method of claim 1, further comprising: displaying the different characters ("results will show ...", page 1)

but Chinese-English Dictionary does not explicitly disclose the font size as being user configurable.

Hill discloses a method for displaying (similar to Chinese-English displaying) where a browser's font size is user defined.

Therefore it would have been obvious to one with ordinary skill in the art at the time of the invention to make the font size of Chinese-English Dictionary user

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configured in order "for example, a sight impaired user may define a large browser font size so that a computer-displayed document is easier to read" (Hill, col. 9, lines 33-35).

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Xing (US PGPub 2003/0115040) discloses a method of translating a domain name entered in one of many different languages into its corresponding English domain name using Unicode.

Tan et al. (USPN 6,314,469) discloses a method of identifying the encoding type of a domain name, converting the encoding to Unicode and translating the Unicode representation to an ASCII representation.

Zhong (USPN 5,319,552) discloses a method of converting Pin Yin into corresponding Zhu Yin (Traditional Chinese) and vice versa using conversion tables.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel G. Neway whose telephone number is 571-270-1058. The examiner can normally be reached on Monday - Friday 8:30AM - 5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R Hudspeth can be reached on 571-272-7843. The fax phone


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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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